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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,961	04/27/2005	Pascal Bruna	Q86739	9115
23373 7590 11/21/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER MATTER, KRISTEN CLARETTE	
			ART UNIT 3771	PAPER NUMBER
			MAIL DATE 11/21/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/532,961

**Applicant(s)**

BRUNA, PASCAL

**Examiner**

KRISTEN C. MATTER

**Art Unit**

3771

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Action is in response to the amendment filed on 10/8/2008. Claims 1 and 13 have been amended, claim 5 has been cancelled, and claims 21 and 22 have been added. Currently, claims 1-3 and 6-21 are pending in the instant application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-9 are dependent on cancelled claim 5, making it impossible to ascertain the metes and bounds of the claims. Examiner has treated these claims as if they were dependent on claim 1 instead of not treating them on their merits as is normally done in such situations. However, appropriate correction of the dependency is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 5,564,414) in view of Barberi et al. (US 6,327,017) and Liou (US 5,895,159).

Regarding claims 1, 2, 3, 10, 12, 13-17, 21, and 22, Walker et al. discloses a fluid dispensing device comprising a body (12, 112) incorporating a dispenser orifice, a reservoir (13) containing the fluid, and a dispensing member (metering valve/stem of MDI), the device being further characterized in that it comprises a dose indicator with an LCD display means (column 7, lines 30-35) that displays the number of doses delivered to the patient (abstract). A switch controls the LCD screen such that *upon actuation of the dispensing member* by a user, two portions of the switch (135) contact each other and an electric pulse is sent to the counting device (130) to change the LCD display (column 7, lines 40-50).

Walker et al. is silent as to the display requiring no energy to keep the display unchanged and only a small amount of energy to change it. However, Barberi et al. discloses a bistable nematic liquid crystal display for use small portable devices (see column 19, lines 50-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a bistable nematic LCD as taught by Barberi et al. in place of the LCD of Walker et al. in order to preserve power. The modified reference would require no energy to keep the display unchanged and only a small electric pulse to change it.

Furthermore, the modified Walker et al. reference does not disclose that the energy to change the display is created by the contacting portions of the switch to create the energy while the device is being actuated and that no battery is required to operate the device. However, Liou discloses a current producer (60) that produces an instantaneous current upon a pressing bar (31) striking an internal flint (column 2, lines 47-53) in order to avoid the use of an external power source (column 1, lines 45-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have replaced the battery and switch mechanism of the

modified Walker et al. device with a pressing bar and flint current producer as taught by Liou in order to produce the electric pulse needed to change the LCD display without the need for an external power supply (i.e., by replacing the “striking bar” and “contacting portion” of Walker et al. seen in Figure 3B with the pressing bar and flint of Liou, respectively).

Regarding claim 11, the dose indicator disclosed by Walker et al. is thin in structure (see figure 2A).

Regarding claim 6, the electric producer of Liou transforms the mechanical movement of the striker pin into an electric pulse that would be used to change the display in the modified device.

Regarding claims 7 and 18, the interaction in the modified device would involve one portion of the device (pressing bar) striking against another portion (flint) of the device during actuation.

Regarding claims 8, 9, 19, and 20, the reservoir and striker pin are displaceable relative to the body (i.e., user presses top of reservoir/pin/pressing bar to actuate dispensing) and the contacting portion (flint) is located on the body and unable to move relative to the body (see Figures 3B and 3D). In addition, Walker et al. discloses a spring for biasing the striker pin away from the contacting portion (see figure 3D).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/532,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the copending claim and the instant claim are minor and obvious from each other. For example, the instant claim 1 is a broader version of the copending claim 5 (i.e. the instant claim 1 does not include the structural element of electronic circuit or the electric pulse coming from an impact of two elements as in the copending claim 5). In the instant claim 1, the structural elements are included in the copending claim 5. Any infringement over the copending application would also infringe over the instant claim. Hence, the instant claims 1-3 and 5-20 do not differ from the scope of the copending claims 1-8.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant's arguments filed 10/8/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments Liou teaches creating the energy in a system that is separate from the dispensing system, examiner notes that Liou was cited merely to show that electrical pulses can be created without a battery by mechanical striking. As discussed above, the electrical pulse of Walker is sent when the dispensing member is actuated. By replacing the contact portions of Walker with a pressing bar and flint piece as taught by Liou, the electrical pulse needed to change the display would in fact be created when a user presses down on the reservoir to dispense a metered dose of medicament.

In response to applicant's argument that the cited references are in entirely different fields and therefore not obvious to combine, examiner points out that Walker and Barberi both deal with portable display devices and therefore one of ordinary skill in the fact could look to these references for teaching LCD displays and various ways to power the displays. In addition, Walker and Liou both deal with dispensing devices that utilize an electrical pulse sent/created by mechanically contacting two portions of the device. Therefore, it would have been obvious to one of ordinary skill in the art to look to Liou for a way of creating an electrical pulse from the mechanical contact to two pieces in a dispensing device because it would have provided a means to produce the pulse without an additional battery source. In addition, it appears as though the device of Walker would perform equally well as modified by both Barbari and Liou.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Here, as discussed above Walker and Barberi both deal with portable display devices that would be obvious to combine for providing various ways to power the display. In addition, Walker and Liou both deal with dispensing devices that utilize an electrical pulse sent/created by mechanically contacting two portions of the device and it would have been obvious to one of ordinary skill in the art to combine the two references to produce the pulse required to change the display without an additional battery source.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen C. Matter whose telephone number is (571) 272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/  
Examiner, Art Unit 3771

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771